

REMARKS/ARGUMENTS

Claim Rejections – 35 U.S.C. §101

In the above-identified Office Action, Claims 4, 18 and 19 were rejected under 35 U.S.C. §101, with the Examiner explaining the rejections as follows (underlining added):

Claims 4 and 18 recite a “computer-readable storage medium encoded with a sequence of instructions”, which is defined on page. Because a transmission media, being a form of electromagnetic energy, do not fall into one of the statutory categories of 35 U.S.C. 101, the claim includes non-statutory subject matter.

Claim 19 is rejected as being dependent upon rejected claim 18.

Applicants respectfully traverse these rejections, because as seen from the above-quoted text the Examiner is rejecting “storage medium” claims, while stating that claiming a “transmission media” is non-statutory. A storage medium, even if broadly interpreted, does not become a transmission media. Hence, the §101 rejection of Claims 4, 18 and 19 should be withdrawn.

For the above-mentioned reasons, this Office Action is **prima-facie defective** and the next office action must be made non-final. If the Examiner continues this rejection in future, the Examiner must explain in detail why they believe a storage medium is same as a transmission media.

In the above-identified Office Action, Claims 5 and 20 were also rejected under 35 U.S.C. §101, with the Examiner stating that signals, being a form of electromagnetic energy, do not fall into one of the statutory categories of 35 USC 101. This rejection is respectfully traversed. A signal is not being claimed per se. Instead, the signal which is being claimed is “encoded with a sequences of instructions” which cause a computer to perform a claimed method. Accordingly, the claimed signal is not naturally occurring, and hence the claimed signal is **NOT** a law of nature, natural phenomena, or abstract idea (which are explicitly excluded from patentability).

Applicants' rejected claims explicitly state that the signal being claimed causes a computer to perform a claimed method. Hence a programmed computer is obtained by use of the claimed signal, which is a useful, concrete and tangible result. Accordingly, the signal being claimed should be patentable subject matter, regardless of the class to which it belongs under §101.

In this context, Applicants respectfully draw the Examiner's attention to the US Supreme Court case, Diamond v. Chakrabarty, 447 US 303, 206 USPQ 193 (1980). The Diamond court was faced with the question of determining statutory class, namely whether a microorganism constitutes a "manufacture" or "composition of matter" under §101. One argument the Government made was that as per congressional understanding the terms "manufacture" or "composition of matter" did not include living things.

Thus the Government's argument in Diamond was similar to the argument now being advanced by the Examiner, in rejecting Applicants' claims as being not in any statutory class.

The Diamond court rejected the Government's argument stating that Congress recognized the relevant distinction was not between living and inanimate things, but between products of nature, whether living or not, and human made inventions. In Diamond, the claimed microorganism was the result of human ingenuity and research and therefore patentable.

In a similar manner, Applicants submit that the relevant distinction here is not between matter and energy, but between (a) products of nature which are nonstatutory and (b) human made inventions which are statutory. Here, the signal being claimed is the result of human ingenuity and research. Therefore the signal is patentable, even if it is assumed that a signal constitutes energy and not matter. Moreover, the Examiner's argument based on the distinction (energy v/s matter) is itself without merit, because matter and energy are interchangeable as per Einstein's law $E=mc^2$.

Note further that Diamond court stated that Congress intended statutory subject matter to "include anything under the sun that is made by man." Clearly, the signal being claimed here is "made by man", and thus worthy of patent protection.

The Diamond court stated that it was not suggesting that §101 has no limits or that §101 embraces every discovery. For example, laws of nature, physical phenomena, and

abstract ideas have been held not patentable. However, the Diamond court concluded that the patentee had produced a new bacterium with markedly different characteristics from any found in nature and one having the potential for significant utility. His discovery was not nature's handiwork, but his own; accordingly it was patentable subject matter under §101.

In a similar manner, in the current case as well, Applicants' signal has markedly different characteristics from any signal that may be found in nature. Applicants' signal also has the potential for significant utility. Applicants' signal is also not nature's handiwork. Accordingly, following the logic in the Diamond case, Applicants' signal is patentable subject matter under §101.

Applicants respectfully submit that the claimed signal is an article of manufacture, which is statutory. Specifically the claimed signal must be made by man, and hence it is a "manufacture" (in contrast to being naturally occurring). In view of the above remarks, Applicants respectfully request withdrawal of the §101 rejection of Claims 5 and 20.

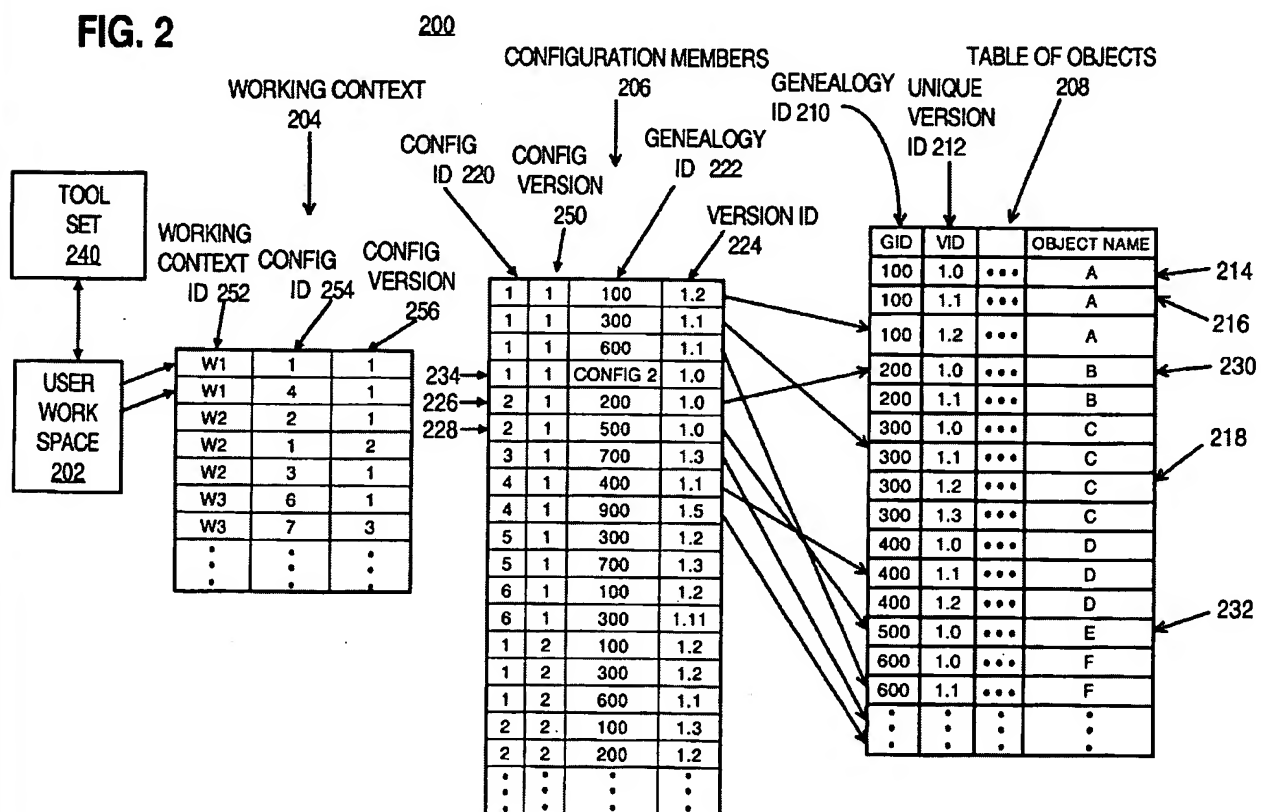
Rejection of Claim 1-6

Claims 1, 2, and 4-6 were rejected under 35 U.S.C. §102(b) as being anticipated by US Patent 6,460,052 granted to Thomas. In explaining the rejection, the Examiner stated that Claim 1's act of "associating no more than one configuration with a workspace from which a query can be issued" was fully disclosed by Thomas. Specifically, the Examiner stated as follows:

associating no more than one configuration with a workspace from which a query can be issued (item 202 in Fig. 2, col. 5 lines 23-24. A workspace is associated with a set of configurations. Since a set may consist of a single configuration, the invention taught by Thomas et al is capable, without further programming or modification, of associating no more than one configuration with a workspace. Col. 7 lines 62-65 indicate that queries can be issued from workspaces, because users ask for data from the database, and are supplied the data through views based on a workspace.).

This rejection is respectfully traversed.

Thomas explicitly states that his workspaces is associated with multiple configurations and such teaching cannot anticipate Claim 1. Specifically, US Patent 6,460,052 discloses an example in which a table (called "working context table") 204 maps version "1" of configuration "1", version "1" of configuration "2" and version "1" of configuration "4" to user workspace 202. Hence, US Patent 6,460,052 discloses mapping of multiple configurations to a single workspace. Moreover, as illustrated in FIG. 2 of US Patent 6,460,052, user workspace 202 has two pointers that respectively point to two rows of a table that contains two different configuration IDs, namely ID1 and ID4 (although these two rows contain the same working context ID W1 and also the same configuration version 1). FIG. 2 is reproduced below for convenience:



In view of the above, Applicants respectfully submit that Thomas does not teach the claimed act of associating “no more than one configuration with a workspace”.

The Examiner’s statement that the Thomas system “is capable, without further programming or modification” is not supported by any prior art citation whatsoever. Accordingly, if this rejection is continued in future, the Examiner is requested to supply a prior art reference. It is the Examiner’s language and the factual basis thereof that is being traversed. In this context, Applicants respectfully draw the Examiner’s attention to the following evidentiary requirement to be met: “If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence.” See MPEP 2144.03. If the Examiner is unable to find an appropriate reference, then Claim 1 must be allowed to proceed to issuance.

In addition, Applicants respectfully submit that even if it were possible to use Thomas system to perform the method of Claim 1, such a possibility alone is insufficient to support an anticipation rejection. At most, such a disclosure by Thomas may constitute a broad genus but it still does not inherently disclose all species within that broad category. Hence, the Examiner must show that a disclosure of the claimed species has been made by Thomas. If Thomas merely invites further experimentation to find the species, such disclosure is insufficient for an anticipation rejection. See Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1367, 71 USPQ2d 1081, 1091 (Fed. Cir. 2004). The Examiner has not shown that associating “no more than one configuration with a workspace” necessarily follows from the teachings of Thomas. See MPEP 2112.

Finally, note that in contrast to US Patent 6,460,052, the Applicants’ Claim 1 associates only a single configuration with each workspace, as stated in the claim. Applicants’ use of a single configuration requires only one hop in Claim 1 embodiments, to go from a user’s workspace to a version resolved view of an object. Such a single hop processing provides advantages in speed and memory which are nowhere disclosed or suggested by Thomas.

Hence, Applicants respectfully request the Examiner to withdraw the prior art rejection of Claim 1. Claims 2-5 depend directly or indirectly from Claim 1 and hence their prior art rejection based on Thomas (in whole or in part) is moot, for the above reasons.

In explaining the rejection of Claim 2, the Examiner stated that Thomas teaches:

retrieving an identity of the configuration from the workspace in which the query originates (col. 9 lines 59-65, when a query is submitted, the version control determines the user's working context);

This remark is respectfully traversed for being **prima facie incorrect**.

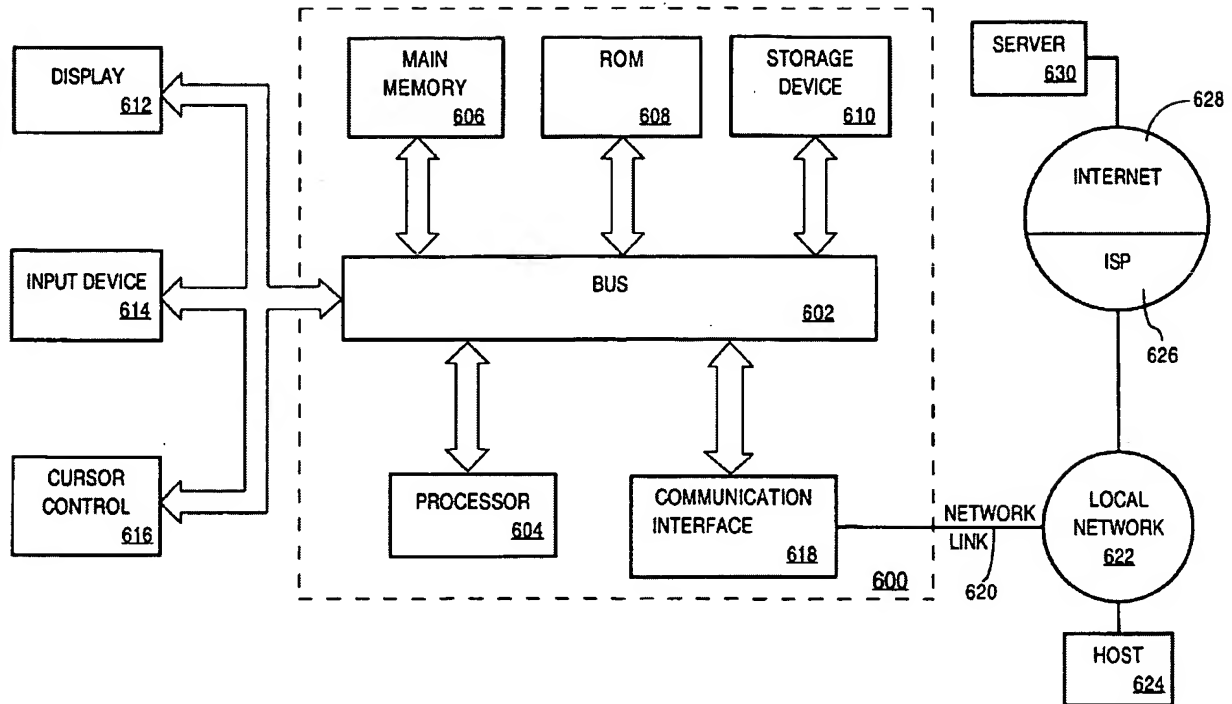
Specifically, as quoted above, the claim language requires retrieving an identity of **configuration** from the workspace. In contrast, the Examiner has stated that the cited "version control determines the user's working context" which is silent about configuration. In fact Thomas teaches to contrary to Claim 2, because of the requirement to use a table in a database. As noted above, Thomas teaches use of a working context table 204 and further discloses in FIG. 2 a configuration members table 206 that provides a mapping of configurations to specific object versions. Therefore, to uniquely identify a single version of an object from a user's workspace, US Patent 6,460,052 requires use of two tables each of which must be looked up (i.e. two look ups). In contrast, Claim 2 is now amended to clarify that an identity of the configuration is retrieved directly from the workspace. Such direct retrieval is nowhere disclosed or suggested by Thomas. Hence this is an additional reason for the patentability of Claim 2.

In explaining the rejection of Claim 6, the Examiner stated that Thomas teaches:

means, coupled to the establishing means and coupled to the storage medium, for associating only one configuration with a workspace of a person who can issue a query (items 604, 606 and 610 in Fig. 6, col. 15 lines 15-20, the means include a processor, memory, and instructions, the processor and memory are coupled to a storage device).

This rejection is respectfully traversed for being **prima facie** defective. Specifically, the only citation is to column 15 lines 15-20 and to FIG. 6 of Thomas which are both reproduced below.

FIG. 6



embodiment of the invention, fine grain versioning is provided by computer system 600 in response to processor 604 15
executing one or more sequences of one or more instructions contained in main memory 606. Such instructions may be read into main memory 606 from another computer-readable medium, such as storage device 610. Execution of the 20

Nothing in the above disclosure by Thomas anticipates the Claim 6 requirement of a means for associating only one configuration with a workspace of a person who can issue a query (emphasis added). Note that this limitation is not present in Claim 1 and hence the Examiner has failed to make a prima facie case for the rejection of Claim 6. Hence Claim 6 is believed to be patentable for this reason, which is in addition to the above-discussed reasons for the patentability of Claim 1.

If the Examiner continues this rejection in future, the Examiner is requested to show where does Thomas teach the language of Claim 6 which has been emphasized above.

Rejection of Claim 7-21

Claims 7-21 were rejected for being obvious over the teachings of Thomas (discussed above) in view of US Publication 2003/0115223 by Scott. In explaining the rejection of Claim 7, the Examiner stated as follows:

As to claim 7, Thomas et al teaches a method for versioning in a repository of a plurality of objects (see Abstract), the method comprising receiving an instruction to insert a first object, checking if the first object is contained in another object, and if not performing acts (a) and (b) else performing act (c):

(a) inserting into a first table, a first row comprising a plurality of values that define the first object, a unique identifier of the first object, and a version number of the first object (Thomas et al item 326 in Fig. 3A, showing a row inserted into a table, the row comprising values that define an object (column to the right of the column indicated by item 320), a unique identifier of the object (item 314), and a version number of the object (item 320)); and

(b) inserting into a second table, a second row comprising the unique identifier of the first object, the version number of the first object, and an identifier of a current configuration (Thomas et al item 206 in Fig. 2, showing a row inserted into a table, the row comprising the unique identifier of the object (item 222), the version number of the object (item 224), and identifier of a current configuration (item 250));

wherein acts (a) and (b) are performed in any order relative to one another (Thomas et al col. 9 lines 56-57 indicates performing act (a) (registering schema), followed by step (b) (generating view definitions)), and alternatively

Thomas et al does not explicitly teach (c) inserting into a third table, a third row comprising a plurality of values that define the first object, a unique identifier of the first object, and at least a current version number of a second object which contains the first object, the second object being not contained in any other object.

Scott et al teaches (c) inserting into a third table, a third row comprising a plurality of values that define the first object, a unique identifier of the first object, and at least a current version number of a second object which contains the first object, the second object being not contained in any other object (items 202, 203, 204, and 205 in Fig. 3. Lines 6-7 of paragraph [0051] indicate that item 202 is a unique identifier of a first object. Lines 1-3 of paragraph [0052] indicate that item 203 is a version number of the first object. Lines 1-2 of paragraph [0053] indicate that item 204 comprises values that define the object. Lines 1-7 of paragraph [0066] indicate that item 205 is a version number of a second object ("parent object") which contains the first object.).

Applicants respectfully traverse this rejection for being **prima facie defective** for at least two reasons as follows.

Firstly, no where in the above remarks has the Examiner indicated where does Thomas or Scott teach conditionally performing different acts. Specifically, the Examiner has not cited any prior art for **checking** if an object to be inserted is contained in another object and then performing two insertions or one insertion, depending on the result of checking. Claim 7 clearly requires such checking. Claim 7's acts (a) and (b) are performed if the object to be inserted is not contained in another object, otherwise act (c) is performed.

Secondly, no where in the above remarks has the Examiner indicated where does Scot teach "the second object being not contained in any other object." As per the Examiner's own remarks, the Examiner has at most shown that Scott's item 205 is a version number of a second object ("parent object") which contains the first object. But the Examiner has not indicated where does Scott teach that this second object is not contained in any other object.

In both the above two arguments, it is the Examiner's language and the factual basis thereof that is being traversed. As noted above, an evidentiary requirement needs to be met because "If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence." See MPEP 2144.03. If the Examiner is unable to find an appropriate reference for these two defects in the Examiner's explanation of the rejection, then Claim 7 must be allowed to proceed to issuance.

Furthermore, Applicants respectfully note that the Examiner's citation to column 9, lines 56-57 of Thomas, by the Examiner's own admission, merely teaches registering schema followed by generating view definitions. Nothing in these steps by Thomas is shown by the Examiner as being performed in response to receipt of an instruction to insert the object.

Hence, if the Examiner continues this rejection, the Examiner is requested to explain how does registering of schema followed by generation of view definitions disclose or suggest performance of the corresponding steps in response to receipt of an instruction to insert an object?

Also, the Examiner's motivation for modification of Thomas by Scott is also traversed as being unsupported by any prior art. In the next Office Action, the Examiner is requested to make particular findings as to the reason a skilled artisan, would have selected these components for combination in the manner claimed. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

Claim 7 and its dependent Claims 8-21 are believed to be patentable over the teachings of Thomas and Scott for at least the above-discussed reasons.

Regarding the rejection of Claim 9, Applicants respectfully raise the same issues as those discussed above, namely that The Examiner's statement that the Thomas system "is capable, without further programming or modification" is not supported by any prior art citation whatsoever. Hence, such a possibility alone, even if disclosed by the Thomas patent, is insufficient to support the rejection of Claim 9.

Regarding the rejection of Claims 15-17, Applicants respectfully raise the same issues as those discussed above, namely that at most Thomas may teach deletion of an object, but such disclosure constitutes a broad genus but it still does not inherently disclose all species within that broad category. Hence, the Examiner must show that a disclosure of the claimed species has been made by Thomas. If Thomas merely invites further experimentation to find the species, such disclosure is insufficient for the rejection. More specifically, the acts of checking in Claims 15-17 are not shown by the Examiner to have been disclosed by Thomas.

Citation of Thomas in Related Patent Application

Applicants hereby draw the Examiner's attention to US Application 10/735,217 which was initially cited in Applicant's specification at page 1 lines 5-9. The Examiner is respectfully requested to thoroughly review the file history of this related application, in view of the fact that a currently-outstanding Office Action also cites to US Patent 6,460,052 granted to Thomas which has been cited against claims in the current application.

**Via Express Mail Label No.
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Respectfully submitted,



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